

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARK S. STEIDINGER and DAVID J. STEIDINGER

Appeal No. 1999-2566
Application 08/868,935

ON BRIEF

Before PAK, OWENS and PAWLIKOWSKI, *Administrative Patent Judges*.

OWENS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the examiner's final rejection of claims 1-3, 12-20 and 23-26. Claims 5-11, which are all of the other claims remaining in the application, have been indicated by the examiner as containing allowable subject matter.

THE INVENTION

The appellants' claimed invention is directed toward methods for making integrated label products. Claims 1 and 26 are illustrative:

1. A method of making integrated, delineated-segment forms comprising:

providing a source of delineated transfer patches spaced along a release-coated side of a carrier web with a predetermined first repeat, each said transfer patch including at least a backer ply having a release coating on one side thereof, and adhesive on said release coated side of said backer ply for adhesively adhering each said patch to said release-coated side of said carrier web and characterized in that said release coating on said carrier web has a comparatively easy release relative to said release coating on said backer ply;

moving said carrier web with said transfer patches through a transfer station;

removing said transfer patches seriatim from said carrier web;

transferring said transfer patches to a reverse side of a form web with a predetermined second repeat different from said first repeat, said adhesive contacting said reverse side of said form web, the other side of said form web being a face side;

die-cutting said form web with a die within at least a

portion of the perimeter of said transfer patches such that said die contacts said face side of said form web first and severs a delineated use segment in said form web and said transfer patch without severing said backer ply;

whereby said delineated use segment remains integral with the remainder of said form web by means of said backer ply, until said delineated use segment is removed therefrom.

26. A method of making a laminated product integral with a

form web comprising:

providing a source of transfer patches spaced along a release-coated side of a continuous carrier web at a first repeat, each of said transfer patches including at least a backer ply, a laminate ply releasably adhered on one side to said backer ply, and adhesive on the other side of said laminate, said adhesive in contact with said release-coated side of said carrier web;

removing said transfer patches seriatim from said carrier web;

then transferring said transfer patches from said carrier web to a reverse side of a form web at a second repeat greater than said first repeat and with said adhesive coating on said other side of said laminate engaging and adhering to said reverse side of said form web, the other side of said form web being a face side;

then die-cutting said form web within at least a portion of the perimeter of said transfer patches by forcing said die at least through said form web from said face side, and then through said laminate coating but not through said backer ply, thereby forming a delineated use segment comprising the die-

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cut portion of said form web and said transfer patch exclusive of said backer ply;

whereby said use segment remains integral with the remainder of said form web, and when said delineated use segment is removed therefrom, said delineated segments of said laminate and said adhesive coating of said transfer patch are removed with said portion of said form web within said die cut, and said backer ply remains secured to said reverse side of said form web.

THE REFERENCES

Holmes et al. (Holmes) 1990	4,902,375	Feb. 20,
Steidinger et al. (Steidinger) 1995	5,441,796	Aug. 15,
Stewart 1996	5,482,328	Jan. 9,

THE REJECTIONS

The claims stand rejected under 35 U.S.C. § 103 as follows: claims 1-3, 12-20, 23 and 25 over Steidinger in view of Holmes;¹ claims 24 and 26 over Steidinger in view of Holmes and Stewart; and claims 1-3, 12-20 and 23-26 over Stewart in view of Holmes.

¹The examiner states (answer, page 3) that claim 23 was inadvertently omitted from the statement of this rejection.

OPINION

We reverse the aforementioned rejections.

Rejection over Steidinger in view of Holmes

Steidinger discloses a method for making an integrated label wherein patches comprised of a backer, a pressure sensitive adhesive layer and a release coating are transferred to a web (11), which is comparable to the appellants' form web, by an applicator cylinder (28) (col. 4, lines 47-52; col. 5, lines 22-29; figure 2). Steidinger does not disclose transferring the patches from a release-coated side of a carrier web, with the adhesive contacting the carrier web, to the reverse side of a form web, with the adhesive contacting the reverse side of the form web, as required by both of the appellants' independent claims 1 and 25.

Holmes discloses transferring a label (32) from a backing web (65) to second backing web (35), the leading portion of the label adhering to the second backing web due to a pressure sensitive adhesive or the like at their interface, at a time when the trailing portion of the label is above the leading

portion, so that a ribbon segment (31) which engages the second backing web is wedged between the label and the second backing web (col. 5, lines 11-28; figure 7).

The examiner argues that it would have been obvious to one of ordinary skill in the art to substitute Holmes' method for that of Steidinger because Holmes' method and Steidinger's method are two equivalent methods for delivering patches to a form web (answer, page 4). The examiner, however, has not established that Holmes' method and that of Steidinger are equivalent. Holmes transfers his label from one backing web to another backing web in a particular way so that a ribbon can be inserted between the label and the second backing web. Steidinger discloses a different method for a different purpose, i.e., making an integrated form having a particular structure.

In order for a *prima facie* case of obviousness to be established, the teachings from the prior art itself must appear to have suggested the claimed subject matter to one of ordinary skill in the art. See *In re Rinehart*, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976). The mere fact that the

prior art could be modified as proposed by the examiner is not sufficient to establish a *prima facie* case of obviousness.

See In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). The examiner must explain why the prior art would have suggested to one of ordinary skill in the art the desirability of the modification. *See Fritch*, 972 F.2d at 1266, 23 USPQ2d at 1783-84.

The examiner has not explained why the applied references themselves would have fairly suggested, to one of ordinary skill in the art, the desirability of substituting Holmes' transfer method for that of Steidinger. Instead, the motivation relied upon by the examiner comes solely from the description of the appellants' invention in their specification. Thus, the examiner used impermissible hindsight when rejecting the claims. *See W.L. Gore & Associates v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984); *In re Rothermel*, 276 F.2d 393, 396, 125 USPQ 328, 331 (CCPA 1960). Accordingly, we reverse the rejection over the combined teachings of Steidinger and Holmes.

Rejection over Steidinger in view of Holmes and Stewart

Stewart discloses a method for making a removable label by adhesively attaching to the bottom surface of a substrate (12) a conventional label stock (51) which includes a face layer (60) and a liner layer (59) joined by a contact adhesive (82). The substrate and the all of the label stock except at least a portion of the liner layer are die cut so that the cut portion of the substrate and label stock can be peeled away from the remaining portion, with the adhesive between the face layer and the liner layer adhering to the face layer so that the label can be adhered to a surface by way of that adhesive (col. 6, line 46 - col. 7, line 39; figure 7). The portion (62) of the face layer which is cut away to form the label increases the thickness of the label such that a light weight substrate can be used, thereby reducing the cost of the label (col. 7, lines 45-54).

The examiner argues that it would have been obvious to one of ordinary skill in the art to replace Steidinger's label structure with another art recognized label structure, i.e., that of Stewart (answer, page 5). The examiner, however, has

not explained why the mere fact that Steidinger's and Stewart's label structures were both known label structures would have fairly suggested, to one of ordinary skill in the art, substituting Stewart's structure for that of Steidinger. More significantly, as discussed above regarding the rejection over the combined teachings of Steidinger and Holmes, the examiner has not explained why the applied references themselves would have led one of ordinary skill in the art to combine the teachings of Steidinger and Holmes. Accordingly, we reverse the rejection over the combined teachings of Steidinger, Holmes and Stewart.

Rejection over Stewart in view of Holmes

The examiner argues that it would have been obvious to one of ordinary skill in the art to substitute Holmes' transfer method for Stewart's patch supply method because they are equivalent methods (answer, page 6). The examiner, however, has not provided evidence which establishes that these methods are equivalents. The examiner's mere assertion is not sufficient to establish a *prima facie* case of obviousness. As discussed above with regard to the rejection

over the combined teachings of Steidinger and Holmes, Holmes transfers his label from one backing web to another backing web in a particular manner so that a ribbon can be inserted beneath the label. The examiner has not explained why this teaching would have led one of ordinary skill in the art to use this technique in Stewart's method wherein conventional label stock is adhered to a form and then the product is die cut.

We therefore conclude that the examiner has not carried the burden of establishing a *prima facie* case of obviousness of the claimed invention over the combined teachings of Stewart and Holmes. Hence, we reverse the rejection over this combination of references.

DECISION

The rejections under 35 U.S.C. § 103 of claims 1-3, 12-20, 23 and 25 over Steidinger in view of Holmes, claims 24 and 26 over Steidinger in view of Holmes and Stewart, and claims 1-3, 12-20 and 23-26 over Stewart in view of Holmes, are reversed.

REVERSED

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Administrative Patent Judge)	
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